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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,979	12/20/2001	Edward S. Beeman	10003825-1	1221

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EXAMINER

BATES, KEVIN T

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,979

Applicant(s)

BEEMAN ET AL

Examiner

Kevin Bates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12-20-02; 10-14-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to a communication made on December 20, 2001.

The Information Disclosure Statements were received on December 20, 2001 and October 14, 2003 and have been considered.

Claims 1-34 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-7, 9-10, 12-17, and 19-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Jebens (6332146).

Regarding claim 1, Jebens teaches a method for managing digital data storage in a computer based data storage system (Column 4, lines 54 – 61), comprising:
acquiring a representation of an image from a client (Column 6, lines 57 – 59);
associating the representation of the image with the client (Column 11, lines 43 – 58);
storing the representation in a first image file format in the data storage system (Column 13, lines 20 – 22); receiving a client request for delivery of the stored representation in a preferred image file format (Column 13, lines 28 – 29); determining if the first image file

format is compatible with the preferred image file format wherein the data storage system translates the representation from the first image file format to the preferred file format when the first image file format is incompatible with the preferred file format (Column 13, lines 36 – 38); and delivering the representation of the image in the preferred file format (Column 13, lines 27 – 36).

Regarding claim 2, which is dependent on claim 1, Jebens teaches that acquiring comprises transforming a hard-copy source into the first image file format (Column 7, lines 48 – 50).

Regarding claim 4, which is dependent on claim 1, Jebens teaches that acquiring comprises a direct network transfer from a client-computing device to the computer based data storage system (Figure 1, elements 12 and 14, where the client connects to the server through a network and more specifically the Internet).

Regarding claim 5, which is dependent on claim 1, Jebens teaches that associating comprises inserting a data storage system file identifier into a transaction record of a database (Column 8, lines 20 – 25).

Regarding claim 6, which is dependent on claim 1, Jebens discloses that storing comprises saving at least one instance of the representation on a primary data storage medium and saving at least one instance of the representation on a secondary data storage medium (Column 13, lines 17 – 26; Column 6, lines 27 – 32, where the system stores originals and copies of the originals and that they are stored separately accessed separately).

Regarding claim 7, which is dependent on claim 1, Jebens teaches maintaining a copy of the representation in the first image file format and in subsequent preferred file formats in the data storage system (Column 13, lines 20 – 26).

Regarding claim 9, which is dependent on claim 1, Jebens teaches that the data storage system translation is initiated by a customer request to access the image (Column 13, lines 27 – 30).

Regarding claim 10, which is dependent on claim 1, Jebens discloses that delivering comprises transferring the representation in the preferred file format over a network (Column 13, lines 27 – 30; Figure 1, element 10, 14, and 16, where a network connects the suppliers to the host and the image server).

Regarding claim 11, which is dependent on claim 1, Jebens discloses transferring the representation to at least one portable data storage media (Column 5, lines 56 – 62).

Regarding claim 12, which is dependent on claim 1, Jebens discloses transferring the representation to a hard-copy medium (Column 5, lines 20 – 24).

Regarding claim 13, which is dependent on claim 1, Jebens teaches editing the representation in accordance with a client request (Column 9, lines 63 – 66); and generating a fee upon storing the edited representation (Column 18, lines 9 – 11).

Regarding claim 14, which is dependent on claim 1, Jebens discloses generating a fee upon translating the representation (Column 18, lines 15 – 16).

Regarding claim 15, which is dependent on claim 1, Jebens teaches generating a fee upon delivering the representation (Column 18, lines 22 – 25).

Regarding claim 16, which is dependent on claim 1, Jebens teaches generating a periodic fee in return for providing data access (Column 17, lines 61 – 65; Column 18, lines 10 – 12).

Regarding claim 17, which is dependent on claim 1, Jebens teaches controlling third party access to the stored representation in accordance with client direction (Column 11, lines 43 – 58).

Regarding claim 19, Jebens teaches a computer based data file storage management system (Column 4, lines 54 – 61), comprising: means for acquiring a digital representation of at least one image from a client (Column 6, lines 57 – 59); means for identifying the client (Column 11, lines 43 – 58); means for storing the digital representation in a first file format (Column 13, lines 20 – 22); means for processing requests for copies of the stored digital representation wherein the request contains information indicative of a preferred file format (Column 13, lines 28 – 29) and a preferred delivery medium (Column 5, lines 56 – 62); means for translating the digital representation to the preferred file format responsive to the determining means (Column 13, lines 36 – 38); and means for transferring the digital representation from the means for storing to the preferred delivery medium (Column 13, lines 27 – 36; Column 5, lines 56 – 62).

Regarding claim 20, which is dependent on claim 19, Jebens discloses the means for controlling third party access to the stored digital representation responsive to a client initiated distribution schedule (Column 11, lines 43 – 58).

Regarding claim 21, which is dependent on claim 19, Jebens discloses the means is responsive to a client request to receive the digital representation in the second file format (Column 13, lines 36 – 38).

Regarding claim 22, which is dependent on claim 19, Jebens discloses the acquiring means comprises a computing device in communication with the client via a wide area network (Figure 1, elements 12 and 14, where the client connects to the server through a network and more specifically the Internet).

Regarding claim 23, which is dependent on claim 19, Jebens discloses the acquiring means comprises a digital imaging device (Column 7, lines 48 – 50).

Regarding claim 24, which is dependent on claim 19, Jebens discloses the translating means is a software program operable on a computing device in communication with the file storage management system (Column 7, lines 65 – 66).

Regarding claim 25, which is dependent on claim 19, Jebens discloses the controlling means comprises a database (Column 4, lines 56 – 61).

Regarding claim 26, Jebens teaches a computer-readable medium having a computer program, comprising: a logic configured to associate a client with a digital representation of an image in a first image file format (Column 11, lines 43 – 58); a logic configured to store the digital representation (Column 13, lines 20 – 22); a logic configured to receive client requests for delivery of the digital representation in a delivery file format (Column 13, lines 28 – 29); a logic configured to retrieve the digital representation from storage responsive to the received client request; a logic

configured to transform the digital representation when the first image file format is not in conformance with the delivery file format (Column 13, lines 36 – 38).

Regarding claim 27, which is dependent on claim 26, Jebens teaches logic configured to receive third-party requests for delivery of the digital representation in a third party desired file format (Column 13, lines 28 – 29), wherein the logic configured to retrieve is responsive to a client initiated third party access grant and wherein the logic configured to transform modifies the digital representation when the first image file format is not in conformance with the desired file format (Column 13, lines 36 – 38).

Regarding claim 28, which is dependent on claim 26, Jebens teaches logic configured to transfer the digital representation from the stored representation to a preferred data-delivery medium (Column 5, lines 56 – 62).

Regarding claim 29, Jebens teaches an electronic data storage system (Column 4, lines 54 – 61), comprising: a primary data storage device (Column 13, lines 17 – 26; the storage for original files which are read only); a computing device communicatively coupled to the primary data storage device (Figure 1, element 10), the computing device having an execution memory containing a data manager application (Column 8, lines 27 – 29); a network interface operable to communicatively couple the computing device to a client and a secondary data storage device (Column 13, lines 17 – 26, where the clients can get access to copies of the original files) via a wide area network (Figure 1, elements 12 and 14), wherein the data manager is programmed to process a client request to store an image by saving a digital representation of the image in a first file format within both the primary data storage device and the

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secondary storage device (Column 13, lines 17 – 26; Column 6, lines 27 – 32, where the system stores originals and copies of the originals and that they are stored separately accessed separately) and wherein the data manager is further programmed to process a request to receive a copy of the image in a preferred file format (Column 13, lines 28 – 29).

Regarding claim 30, which is dependent on claim 29, Jebens teaches an image acquisition device in communication with the computing device and configured to generate the digital representation (Column 7, lines 48 – 50).

Regarding claim 31, which is dependent on claim 29, Jebens teaches a data storage translator configured to receive the digital representation in the preferred file format and to apply the digital representation to a data storage medium responsive to the request to receive (Column 13, lines 28 – 36).

Regarding claim 32, which is dependent on claim 29, Jebens teaches that the data manager comprises software configured to translate the digital representation from the first file format to the preferred file format (Column 13, lines 36 – 38).

Regarding claim 33, which is dependent on claim 29, Jebens teaches that a peripheral device communicatively coupled to the computing device configured to receive the digital representation and generate a hard-copy rendition of the image (Column 5, lines 20 – 24).

Regarding claim 34, which is dependent on claim 29, Jebens teaches an image editor communicatively coupled to the computing device (Column 10, lines 10 – 12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jebens in view of Wright (6674924).

Regarding claim 3, Jebens does not explicitly indicate acquiring comprises processing at least one file associated with an electronic mail message.

Wright teaches an document image repository (Column 3, lines 19 – 26) that includes having an image sent as an email attachment (Column 16, lines 17 – 19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Wright's teaching of receiving images through email attachments in Jebens' system in order to allow the system to be the most convenient to the users and provide many forms of image reception.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jebens in view of Boudris (6886018).

Regarding claim 8, which is dependent on claim 1, Jebens does not explicitly indicate that the data storage system translation is initiated by the obsolescence of the first file format.

Boudris teaches a file system with various file formats that transforms obsolescence files into a new current version (Column 9, line 56 – Column 10, line 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Boudris' teaching of removing obsolescence files in a data base in favor of the current format in Jebens' system so that when a user is getting a data file from a database, that file is always transformed into the current version of the file thus not allowing the client to receive obsolete data files (Column 10, lines 2 – 9).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jebens in view of Wahl (6324654).

Regarding claim 18, which is dependent on claim 6, Jebens does not explicitly indicate that the secondary data storage medium is geographically disposed from the primary data storage device.

Wahl discloses a file server with a primary (Figure 1, element 12) and a secondary storage (Figure 1, element 13), where the secondary data storage medium is remote from the primary storage device (Figure 1, element 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Wahl's teachings to improve Jebens' system to allow the secondary storage device to be remote from the primary storage device, which allows the data to be redundant and available in case something happens at the primary or secondary site (Column 1, line 65 – Column 2, line 3).

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent No. 5168444 issued to Cukor, because it discloses a centralized image repository with image processing.

U. S. Patent No. 6557039 issued to Leong, because it discloses having a centralized archive of data.

U. S. Patent No. 5754308 issued to Lopreseti, because it discloses archiving and processing documents.

U. S. Patent No. 6590674 issued to Orton, because it discloses a file formatting system which maintains original copies.

U. S. Patent No. 6522418 issued to Yokomizo, because it discloses receiving image data from clients and changing its format.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bates whose telephone number is (571) 272-3980. The examiner can normally be reached on 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KB

KB

August 18, 2005

Bharat Barot
BHARAT BAROT
PRIMARY EXAMINER